

REMARKS

This patent application presently includes claims 1-52 and 58-66, all of which stand rejected. The claims are amended to define the applicant's invention more clearly, certain claims are rewritten in independent form, and all rejections are respectfully traversed. Claim 67 was canceled, because it was discovered to be redundant of claim 27.

All claims were rejected under 35 U.S.C. §112 as being non-enabling. This rejection is respectfully traversed.

Initially, it is noted that, along with the preliminary amendment, the applicants submitted the declaration of Brad Myers. Dr. Myers was presented, not only as a technical expert in response to the Examiner's affidavit, but also as an expert on the level of skill in this art and the enablement of the disclosure of the present patent application to a person of ordinary skill in the art. As detailed in his declaration, Dr. Myers has many years of experience teaching under-graduates and graduate students in the field of the present invention and is therefore uniquely qualified to know the level of skill in this technology, the level of skill required to understand the present disclosure and whether the disclosure would be enabling to those of ordinary skill in the art. It is noted that the Examiner did not even consider Dr. Myers' declaration in this regard, but instead chose to maintain his own opinion regarding enablement. Dr Myers' declaration is the only authoritative evidence in the record regarding enablement, and the Examiner should not substitute his opinion for the sworn analysis and testimony of an expert.

The Examiner has now focused his opinion on three terms: "intrusively", "unpredictable", and "completely beyond user control." He concludes that these terms involve {W:\02875\100G342-US1\00090127.DOC *02875100G342-US1* }

subjectivity and are therefore, non-enabling. Nothing could be further from the truth. The term “intrusive” is a term of art as used with respect to online advertising, and those skilled in the art would understand very well what is meant by intrusive advertising. For example, the Murray patent which the Examiner cites in the rejection under 35 U.S.C. § 102 makes this clear. See, for example, Column 2, Lines 43-46 of U.S. Patent No. 6,601,659. Accordingly, there is no basis to consider “intrusively” either subjective or non-enabling.

It is quite astounding that the Examiner would consider “unpredictable” either subjective or non-enabling in the context of the present invention. The animated character of the present invention does not usually appear on the page being viewed when it first comes up on the screen, but can appear at anytime determined by the software and not the user. The character can also appear anywhere on the screen. This in contrast to banner ads, for example, which always appear as the page does. Moreover, they appear in a predetermined space, and that space appears as an empty block until the ad fills it (not to the user’s surprise). It is therefore not possible that the user could predict with the present invention that the character will appear, when it will appear or where. There is nothing subjective about this, and those skilled in the art would understand quite clearly what is intended. Accordingly, this rejection is improper and should be withdrawn.

Regarding “completely beyond user control”, there is nothing subjective or non-enabling about this. In fact, in his declaration, Dr. Myers specifically addressed the issue raised by the Examiner that the invention could not achieve this because a user could always turn off the computer. He pointed out that those skilled in the art would realize that this feature applies only in the situation when the application program is running and not the absurd situation in which the user “pulls the plug.” Clearly this is not a way of controlling the character, but completely disables all

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operation of the computer. Dr. Myers, in fact, pointed out that the application discloses one specific way to achieve this feature, and that would be by placing the character in the uppermost layer of the application window so that the user cannot scroll it off the screen or cover it up. For the Examiner to persist in the position that this is somehow subjective or non-enabling is quite surprising. What is even more surprising is that most of the claims are rejected on the basis of this limitation, while the preliminary amendment remove it from almost all of the claims and retained it only in a few dependent claims. Thus, this is not a legitimate basis for rejection and should be withdrawn.

Regarding this last basis for the rejection, it should be clear that the applicant does not agree with the Examiner's rejection. However, in order to avoid this as an issue, this language has been amended in a number of claims to include the language "while the application program is running." This was done, not with the intent of acquiescing in the Examiner's rejection, but only to avoid this as an issue.

All claims were rejected under 35 U.S.C. §112 as indefinite, the Examiner referred to the terms "intrusively", "unpredictable" and "completely beyond user control", asserting that they are indefinite, because they are subjective. It is believed that this issue was treated extensively above and that the same arguments apply here. It is therefore believed to be clear that this rejection is improper and should be withdrawn.

All claims were also rejected under 35 U.S.C. §112 as indefinite for lacking an antecedent basis for certain terms. The Examiner cited specific terms and specific claims in this regard. The undersigned has reviewed all of the Examiner's assertions and, except as specifically discussed below, has made appropriate amendments to the claims to provide an antecedent basis for

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the language cited by the Examiner. Except as specifically discussed below, this was the only reason for making most of the claim amendments. It is believed that all of the terms in all of the claims now have a proper antecedent basis, and this rejection should be withdrawn.

The Examiner rejected Claims 1, 3, 8, 12, 21, 34, 36, 39 and 60 for lacking an antecedent basis for “the steps.” It is believed that this was erroneous because the context in which this language occurs is “the method comprising the steps of.” This is conventional preamble language for introducing the steps of a method, and it is believed that no antecedent basis is required here.

Claims 7, 19, 23, 29, 38, 46, 51, 63, 64 and 65 were rejected for lacking an antecedent basis for “the user’s control.” The claims in question all contain an antecedent basis for the user. Moreover, the user is associated with a computer or computer system that he operates. It is therefore implicit that the user must exercise some control over the computer. Clearly, this is a sufficient antecedent basis for “the user’s control” in the claims and no further basis is required.

Claims 5, 17, 49 and 59 were rejected for failing to provide an antecedent basis for “the existing image.” In each case, the portion of the claim involved contains an antecedent basis at the beginning of that sub-portion in the form of “the character overlies an existing image.” Accordingly, this rejection is erroneous and should be withdrawn.

Claim 29 was rejected for failing to provide an antecedent basis for “the characters.” The context is “one of the characters.” An antecedent basis exists at Line 2 where reference is made to “a plurality of characters.” Accordingly, this rejection should be withdrawn.

Claims 10, 21, 22, 41, and 62 were rejected for failing to provide an antecedent basis for “the content provider.” Claims 10 and 21 each have a specific antecedent basis for this term (Line 2 in Claim 10 and Line 7 in Claim 21). Claim 22 depends from Claim 21 and therefore also has an antecedent basis. Claim 24 has an antecedent basis at Line 2, and Claim 62 has an antecedent basis at Line 2. Accordingly, this rejection should be withdrawn.

Claim 11 was rejected for lack of an antecedent basis for “the same.” This term appears in the context of the clause “at the same time”, so there is no antecedent basis required in this case, since clearly an element of the claim is not being referred to. This rejection should be withdrawn.

Claims 13 and 22 were rejected for lack of an antecedent basis for “the number.” In Claim 13, the context is “the number of accesses” and in Claim 22, the context is “the number of times.” Clearly, this is a permissible use of the word “the”, since it is not referring to an actual element. Moreover, use of the term “a” would be unclear. Accordingly, this rejection should be withdrawn.

Claim 13 was rejected for lack of an antecedent basis for “the duration.” The full context is “the duration of an access.” Again, this is a proper grammatical use of the term “the” which does not refer to an actual element, and using the term “a” would be unclear. Accordingly, this rejection should be withdrawn.

Claim 17 was rejected for lack of an antecedent basis for “the application program.” An antecedent basis for this term exists at Line 3 of the claim. Accordingly, this rejection should be withdrawn.

Claim 17 was rejected for lacking an antecedent basis for “the existing.” The context in which this term is used is “the existing image”, and this finds an antecedent basis in the preceding line.” Accordingly, this rejection should be withdrawn.

Claim 18 and 19 were rejected for lack of an antecedent basis for “said control signals.” This term finds an antecedent basis in Claim 17, Line 11. Accordingly, this rejection should be withdrawn.

Claim 22 was rejected for lack of an antecedent basis for “the media.” The full context is “the media source”, which finds an antecedent basis in Claim 21, Line 5. Accordingly, this rejection should be withdrawn.

Claim 31 was rejected for lack of an antecedent basis for “said media signal.” This term finds an antecedent basis in Claim 27, Line 5. Accordingly, this rejection should be withdrawn.

Claim 33 was rejected for lack of an antecedent basis for “the same.” The full content of this term is “at the same time as.” This clause is appropriate and does not require an antecedent basis. Accordingly, this rejection should be withdrawn.

Claim 25 was rejected for lack of an antecedent basis for “said control signals.” This finds an antecedent basis in Claim 12, Line 11. Accordingly, this rejection should be withdrawn.

Claim 49 was rejected for failing to provide an antecedent basis for “the existing image.” This term finds an antecedent basis two lines prior. Accordingly, this rejection should be withdrawn.

Before proceeding to the rejections over prior art, the undersigned refers to the paragraph appearing at the bottom of Page 8 of the Office Action, in which the Examiner refers to the personal interview held in the parent patent application. It is noted that the Examiner states that agreement was reached, that “the steps including a character beyond user control while application running on the same window/screen display with a transparency feature was unique.” Despite the Examiner’s statement, it is noted that a number of claims presently in the application, namely Claims 5, 17, 27, 36, 44, 49 and 59 include these limitations, yet they continue to be rejected.

Claims 5, 17, 27, 44, and 59 have been rewritten in independent, amended form to demonstrate this to the Examiner. In the process, reference has also been eliminated to the terms “intrusively”, “unpredictable” and “completely beyond user control”, in order to eliminate these as issues.

In Claims 5, 17 and 27, the character is located in an uppermost layer of the application program window so that a user cannot move it off the display screen or cover it with other objects, (beyond use control) and it overlies an existing image, while having a portion which is transparent, so a portion of the existing image can be seen through it. Similar limitations exist in Claim 59. Accordingly, these claims all include the combination of features which the Examiner considered patentably distinguishable.

According to Claim 36, the character is introduced into the display screen on which there is an image produced by an application program. The character similarly overlies an existing image and has a transparent portion. Accordingly, this claim also includes the combination of features found to be patentable by the Examiner.

According to Claim 44, the character is produced “on the client’s computer display of the content” and “appears on the content.” Furthermore, the character overlies an existing image and a portion of it is transparent. Accordingly, Claim 44 also includes the patentable combination of features.

According to Claim 49, the character is produced on the display of the application program and it overlies an existing image produced by the application program and a portion of it is transparent. Accordingly, Claim 49 also includes the patentable combination.

It is therefore clear that Claims 5, 17, 27, 36, 44, 49 and 59 all include a combination of features found to be patentable by the Examiner and should be allowed.

Claims 6-10 depend from Claim 5, Claims 18-20 depend from Claim 17, Claims 28-32 depend from Claim 27, and Claim 45 depends from Claim 44. Accordingly, these claims are allowable owing to their dependence from an allowable claim.

Allowable claims 5-10, 17-20, 27-32, 36, 44, 45, 49 and 59 discussed immediately above contain a combination of features which is not taught or suggested by any of the prior art cited by the Examiner for rejecting claims under 35 U.S.C. §102 or 35 U.S.C §103. Accordingly, these claims are believed to be allowable over all of the prior art in the record and will not be discussed further below. These claims will hereafter be referred to as the Initial Claim Group.

All of the claims were rejected under 35 U.S.C. §102. For the reasons explained below, all of these rejections are improper and should be withdrawn.

Before addressing the rejections, it is noted that the Examiner, has again, raised an issue regarding the filing date of the present application, suggesting that it was file in 2001. It is believed that this issue has been resolved in the record. The filing date of the present patent application for all purposes except 35 U.S.C. §102(e) is November 11, 1999, the filing date of Provisional Application No. 60/164,985. It is requested that the Examiner states this unequivocally on the record. If the Examiner has some reason for disagreeing with that date, he should state it on the record, as the undersigned feels a need to petition this issue immediately if the Examiner does not accept that date.

All claims were rejected under 35 U.S.C. §102(b) as anticipated by JP 10-222341 and CA 2,384,315. Initially, it is noted that the rejection over the Canadian reference is improper, since it was published December 10, 1998, which is not one year before the filing date of the present application. The Examiner may wish, instead, to apply the U.S. counterpart which is U.S. Patent No. 6,061,659.

It is also noted that the rejection over the Japanese and Canadian references is decidedly improper. Basically, the Examiner states that the rejection discussion by the foreign patent offices could be used to reject the claims in the present application. However, the Office Actions in the foreign applications were issued under foreign law which has different standards for patentability. Nowhere does the Examiner state the basis for the rejection in the present application. Specifically, the Examiner does not point out how the elements of any of the rejected claims are found in either of these references. Nevertheless, the Applicant will respond to this rejection for completeness of the response.

The Japanese Office Action

In the Japanese Office Action, the Examiner rejected the claims as obvious over Reference 1, JP 10-222341. In the discussion which follows, we will not focus on the distinctions presented above with respect to the Initial Claim Group, which are believed to distinguish patentably over this reference. In all cases, the Examiner referred to in this section is the Japanese Examiner, unless specifically indicated otherwise.

At the outset, it is noted that the Japanese Examiner rejected the claims as obvious over Reference 1. On this basis alone, the U.S. Examiner's rejection in the present application must fail. The obviousness rejection incorporates an admission that the claim has differences over the reference and therefore the reference cannot anticipate the claim. Since the Examiner has adopted the Japanese Examiner's action he has inherently admitted that there is no anticipation. Nevertheless, we proceed with a full response to the Japanese action for completeness and to demonstrate that an obviousness rejection would also be inappropriate in the present application.

Reference 1 basically discloses a moving icon for a computer screen. A lotus determining means generates a moving locus and a trigger signal, which causes an icon on a computer screen to move along the locus. A moving point recording means tracks the moving position coordinates of the image on the display. A pointing means is operable to move a pointer on the screen under control of the operator, and a pointer position recording means tracks the pointers moving position coordinates. Position coordinate comparing means compares the pointer's position coordinates with the icon's position coordinates and pointer output auxiliary means outputs a

specific instruction signal after a specific operation of the pointer means (e.g. clicking the pointer) when the coordinates of the pointer and the icon match. In operation, the user tries to chase and catch up with the icon using the pointer means and to perform an operation, such as clicking on the character. When he succeeds, a specific instruction signal is issued by the auxiliary means which activates a program that adds auxiliary functions. See Paragraph 0021 of Reference 1.

In summary, the purpose of the invention of Reference 1 is to generate an icon which moves in a manner that is unknown to the user, so that he may click on that icon in order to enable an auxiliary function. In other words, the whole purpose of the invention of Reference 1 is for the user to *exercise control* over the icon or character. Without the exercise of control over the character, the invention of Reference 1 becomes inoperative and useless and serves no purpose.

The purpose of the present invention is to provide information on a computer screen. The present invention is contrasted in the application with banner advertisements which are so common on the Internet. The problem with those advertisements is that the user can exercise control over them and can simply ignore them by scrolling past them.

One of the novel features of the present invention is that a character is introduced to modify and appear on the image produced by an application program and the character is completely beyond the user's control. As pointed out above, those skilled in the art would realize that the character is intended to be out of the user's control while the application's display is present on the screen, since any other interpretation would not make sense to those skilled in the art, and it is always possible to turn off the computer, in which trivial case the invention becomes meaningless.

Claim 1 was rejected as obvious over Reference 1. However, Claim 1 specifically recites that an image produced by an application program on a display screen of a computer system is modified by introducing on the image a character which is completely beyond the user's control while the application is running. As pointed out above, it is essential to Reference 1 that the user be capable of exercising some control over the character, at least to the extent of being able to capture it so as to click on it. Otherwise, the entire purpose of reference 1 is defeated. Under U.S. practice, this alone is an adequate basis for establishing lack of *prima facie* obviousness. In fact, the subject matter of claim 1 is completely contrary to the disclosure of Reference 1, and it could not be said that Claim 1 is obvious over Reference 1 or even suggests the subject matter of Claim 1. On the contrary, it is clear that Reference 1 teaches the opposite and would discourage those skilled in the art from arriving at the subject matter of Claim 1.

If anything, Reference 1 is the same as the undesirable banner advertisements discussed in the present application, in that the user can exercise control over the character. Thus, those skilled in the art would never be led to the presently claimed invention from the disclosure of Reference 1.

Claim 2 was rejected on the same basis as Claim 1. Since this claim incorporates all the subject matter of Claim 1, it is patentable for the same reason as Claim 1.

Claim 3 was also rejected as obvious over Reference 1. This claim adds the feature that the character is located in the uppermost layer of the application program window in an operating system which produces multi-layered window images. The Examiner's only justification for this rejection is that operating systems with multi-layered windows on the screen are well known and

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this method could have easily been performed by one skilled in the art. Such an obvious to try rejection is inappropriate under U.S. law. Furthermore, the Examiner is taking a hindsight approach, which is also unacceptable under U.S. law. He is merely looking at what the claim says and concluding that the technology was available to do what the claim says (something we agree with), so one skilled in the art could have done it. However, he provides absolutely no explanation why any one skilled in the art *would have* done what is claimed (other than the disclosure of the present patent application), only that he could have accomplished it. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 U.S.P.Q. 2nd 1780, 1783 (Fed Cir. 1992).

Specifically, in accordance with the concept of claim 3, a multimedia character is introduced to modify the image produced by an application program and the character is placed in the uppermost layer of the application program Window. This makes it impossible for the user to move the character off the viewed display of the application program or to cover it with other objects. According to Reference 1, a user would never want to move the character off the display, but would want to *cover* it with the pointer and, essentially capture the character by clicking on it. Hence, the disclosure of Reference 1 would never lead those skilled in the art to the subject matter of Claim 3, even though multi-layered windows in an operating system were known.

Claims 4-6 were also rejected as obvious. These claims are dependent from Claim 1 or Claim 3 and incorporate the same distinctions that were pointed out above with respect to those claims.

Claim 5 includes the features of claim 3 and adds the feature that the character overlies the application program image and a portion of the character is transparent, so that a portion of the existing image can be seen through it. In windows, for example, when one image is placed over another, that image is in the form of a rectangular window. By making portions of the character transparent, for example, all regions outside the character itself, the window takes the shape of the character, so that the character appears to be independent of any window even though it is over the display of the application program. This feature is not taught or suggested by Reference 1 or otherwise known on any basis presented by the Examiner. Accordingly, Claim 5 is believed to be allowable on this further basis.

Claim 7 was also rejected as obvious. This dependent claim adds the feature that the characters are selected and controlled according to information from the user's computer which is not under the user's control and technical features available in the user's computer. The Examiner's only reason for this rejection is that "it is known technology to change a process in accordance with a technical feature of the user's computer" and this would have easily made a person skilled in the art provide the claim construction. We believe the Examiner is wrong. First of all, Claim 7 incorporates the unique features of Claims 5 and is patentable for at least that reason. Furthermore, the claim provides that characters are selected and controlled according to information which is *not* under the user's control, and this makes the process adaptable to different computers. Also, this is another way of achieving a character which is completely beyond the user's control. Regarding controlling the characters based on technical features available in the user's computer, this is exemplified by the method of Fig. 3 where a different control script and, therefore a different control method, is utilized automatically, depending on the technology available in the user's

computer. There is not the slightest suggestion for this in Reference 1 and the Examiner has not presented a reference that would suggest such a feature.

Claims 8-11 were rejected as obvious over Reference 1 on substantially the same basis as discussed above. However, these claims depend from Claim 5 and incorporate the same patentable features as that claim. At least with respect to Claim 8, a number of additional features appear in the claim which have not even been addressed by the Examiner, and these features are believed to make the claim allowable on its own merits.

Claims 12 and 14 were rejected as obvious over Reference 1. Claim 12 provides that the character controlling server transfers control signals to the client that produce a character which appears *on the content* received from a content server. There is not the slightest suggestion in Reference 1 that the character appears over content. Though Reference 1 discloses that a character appears on the screen in the manner of an icon and that a separate locus program activates to move it, as is well known, icons are covered by content. Also, other advertising, such as banners, appear along with the content and therefore scrolls with the window. The character according to Claim 12 is *over* the content and, should it move, it will uncover the content. This, alone, is more likely to attract the user's attention than a banner advertisement.

Claims 13-20 depend from Claim 12 and incorporate the same patentable distinctions as Claim 12. These claims are therefore patentable for the same reasons.

In addition, Claims 15 and 17 are believed to be allowable on their own merits for the same reasons as Claims 3 and 5, respectively.

Claims 21 and 22 were rejected as obvious over the combination of References 1 and 2. The Examiner cited Reference 2 (JP 11-242714) for its disclosure of an electronic greeting card system using the worldwide web. However, the combination of References 1 and 2 still does not overcome the deficiencies of Reference 1. That is, Claim 1 provides that the character is completely beyond the user's control while the application program is running. In addition, the method of Claim 21 involves four computers: the sender's and recipient's computers, the character controlling server and the content provider server. Unlike the conventional greeting card, the invention of Claim 21 provides for the character server, which produces the greeting, to provide a signal to the recipient that causes information provided by the content provider to be added as background to the greeting. This background remains after the message is delivered. Thus, the background provides an additional opportunity to deliver an advertising or other message. These features are not taught or suggested by either reference or their combination. Claims 21 and 22 are therefore allowable.

Claims 23 and 24 were rejected as obvious over Reference 1. Claim 23 relates to a system for modifying an image produced by an application program on a user's display, which system includes a generator of media signals which produce in the *display of the application program* a multimedia character which is completely beyond the user's control. First of all, as already pointed out above, the character is produced over the display of the application program which is distinctive over Reference 1. In addition, as explained with respect to Claim 1, the character is completely beyond the user's control, which also distinguishes patentably over Reference 1.

Claim 25 was rejected as obvious over Reference 1. This claim includes the same features as Claim 5 and is allowable for the same reasons.

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Claims 26-33 were rejected as obvious over Reference 1. These claims incorporate the features of Claims 23 and/or 25 and are believed to be allowable for the same reasons. However, certain of these claims are believed to be allowable on their own merits. For example, Claim 27 is allowable for the same reason as Claim 5 and Claim 29 is allowable for the same reason as Claim 19. In addition, each of Claims 25-33 is allowable for the same reasons as the corresponding claim referenced by the Examiner.

The remaining claims were not present in the Japanese application at the time of the Office Action, but it will be appreciated that arguments comparable to those presented above apply.

The Canadian Office Action

In the Canadian Office Action, the Examiner rejected the claims as obvious over CA 2,296,355 (Murray). In the discussion which follows, we will not focus on the distinctions presented above with respect to the Initial Claim Group, which are believed to distinguish patentably over this reference. In all cases, the Examiner referred to in this section is the Canadian Examiner, unless specifically indicated otherwise.

At the outset, it is noted that the Canadian Examiner rejected the claims as obvious over Murray. On this basis alone, the U.S. Examiner's rejection in the present application must fail. The obviousness rejection incorporates an admission that the claim has differences over the reference and therefore the reference cannot *anticipate* the claim. Since the Examiner has adopted the Canadian Examiner's action he has inherently admitted that there is no anticipation. Nevertheless, we proceed with a full response to the Canadian action for completeness and to demonstrate that an obviousness rejection would also be inappropriate in the present application.

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The obviousness rejection of the claims is improper. First of all, Murray does not teach or suggest modifying the image produced by an application program on the display. If you refer to Figs. 1 and 6 of Murray, you will note that the signal provided by the content server is modified *before* it reaches the client's computer, so that the computer receives a modified image signal, which is the received content, and the corresponding application program would display exactly the signal that is received. Not only is there no modification of the image, but as animated character is not introduced to the screen over the content signal. Anything that ultimately appears on the screen arrived with the original content signal.

Secondly, the additional content inserted in the signal in Murray is scaled. There is a reason for that. Comparing, for example, Figs. 5a and 5b it will be noted that the coffee can 94 is inserted so as to be part of the original image. That is the reason for the scaling. The idea is not to make the inserted component stand out. In contrast, Claim 1 provides that the character should be inserted into the display of the application intrusively. This is certainly not the intention of Murray. Since the present invention achieves the opposite effect of Murray or what Murray desires *not* to do, it cannot be said that Claim 1 is obvious over Murray.

Claims 2-11 incorporate the same distinctions over Murray as Claim 1 and are believed to be allowable for the same reasons. However, certain of the claims include additional novel features. For example, in Claim 3, the character is located in the uppermost layer of the application program window. There is not the slightest teaching or suggestion of this in Murray. In addition, according to Claim 5, the inserted character overlies an existing image and a portion of the character is transparent so that the existing image can be seen through it. In windowing programs like Windows, each window or inserted layer is, in fact, a rectangle. By making a portion of the

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character transparent, for example, everything outside the character itself, and assuming that the frame and similar portions of the character's window are inhibited, the character's window can be made to have exactly the outline of the character and an observer will never know that it is actually a window. This feature is not taught or suggested by Murray.

Claim 12 is unobvious for the same reasons as Claim 1. However, it additionally provides that the content received by the user includes a tag which causes the user to communicate with a character controlling server which then transfer additional signals to the user which produce the multimedia character on the content. In other words, the original content is received by the user, it causes communication with another server, and that server sends a signal to the user which then changes the display produced by the user's computer. This is clearly contrary to and unobvious over Murray, which simply provides a modified image to the user's computer.

Claims 13-20 are dependent from Claim 12 and are believed to be unobvious for the same reasons. However, Claims 15 and 17 include the distinguishing feature discussed with respect to Claims 3 and 5, respectively.

Claim 21 is unobvious over Murray for the same reasons as Claim 1, however, Claim 21 also includes the distinguishing features discussed with respect to Claim 12. In addition, the signal received by the user causes a call to a page which provides background. This is not taught or suggested by Murray.

Claim 23 is unobvious for the same reason as Claim 1. Claims 24-32 include the same features and are unobvious for the same reasons. However, Claims 25 and 27 incorporate the distinctions discussed above with respect to Claims 3 and 5, respectively.

Claim 33 depends from Claim 1 and is allowable for the same reasons.

The remaining claims were not present in the Canadian application at the time of the Office Action, but it will be appreciated that arguments comparable to those presented above apply.

For all of the above reasons, it will be appreciated that neither the Japanese reference nor the Canadian reference provides an adequate basis for rejecting the claims as either anticipated or obvious.

All of the claims were rejected under 35 U.S.C. §102(b) based upon a public use or sale of the invention. The Examiner refers specifically to information posted on the assignee's website. He uses this information to establish a public use or sale date of 1999 and thus asserts that the present application was filed in 2001. However, as pointed out above, the filing date of the present application is November 11, 1999, and it is assumed that the Examiner will confirm this in the next Office Action. Accordingly, this rejection is improper and should be withdrawn.

The Examiner also bases his rejection upon statements made in the declaration of Brad Myers to the effect that the Flash program and various Javascript have long been available in the prior art. This information is not only taken out of context but is entirely irrelevant. It was presented to the Examiner to show that the basic technology utilized for the invention is well known in the art. This is not pertinent to any of the subject matter actually presented in the claims. The

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rejection does not even address the actual claim language. Accordingly, this rejection should also be withdrawn.

As an example of the Examiner's failure to consider the claim language, the Examiner states that JUNO includes the step of "introducing or displaying into a computer screen a multimedia animated character." However, claim 8 recited that the character was introduced "into the application program image", claim 12 recited that it was introduced into the "display of the content", claim 21 recited that the character "appears on the content", claim 25 recited that the character is "in the uppermost layer of the application program window", claim 34 had the same recitation, claim 49 recited that the character "overlies an existing image produced on the screen by the application program", and claim 66 recited that the character is "in the uppermost layer of the application program window." In addition, claim 1 has now been amended to recite that the character is introduced "into the image" (the image is "produced by an application program"), claims 24 and 36 have been similarly amended. Thus, at the time of the Office Action, most of the claims required something quite different than introducing or displaying the character on the screen, and all claims now require it. Specifically, the JUNO pop-up advertising does not appear in the window, image or content of the application program. It, in fact, appears in a window which is separate from the application program and its content.

This fact is addressed in Paragraph 13 of the Myers declaration. He refers to this type of advertisement as "Pop-up advertisement." He notes that when such advertisement is presented to a user observing the display of an internet page, the pop-up advertisement does not appear in the display of the page of the application program (e.g. the browser) that the user is observing. It appears in a separate window. He further notes that such windows are not out of the user's control, {W:\02875\100G342-US1\00090127.DOC *02875100G342-US1* }

but can easily be closed or moved. He contrasts the multimedia character of the present invention, which is in the same display or window as the internet page and is out of the user's control. He also notes that, since pop-up advertisement is in a separate window, it remains on the user's display even after the browser is closed. The user would then have to close each pop-up window separately.

However, the Examiner has entirely ignored Dr. Myers' Declaration. Moreover, the Examiner is not free to do so. 37 C.F.R. § 1.104(d)(2) states that the Examiner's Affidavit "shall be subject to contradiction or explanation by the Affidavits of the Applicant and other persons." It is therefore believed that the Examiner's failure to consider the Myers Declaration and to justify his differences with it constitutes reversible error. Dr. Myers explained in Paragraph 14 of the declaration that the JUNO pop-up advertisement does not meet the claim description of the present invention, because it is not out of the user's control and because it does not appear in the same screen display or window as the application program.

Accordingly, it is eminently clear that the obviousness rejection is improper and should be withdrawn.

By this time, the Examiner, no doubt, understands (or should understand) that introduction of the character in accordance with the present invention is quite different from pop-up advertising, in that the character is introduced into the display of the application program or the same window as the program. This is not simply descriptive language, but a physical difference of how and where the character is introduced. In fact, a number of the claims have been amended to recite that the character is introduced so that it appears ..., in order to eliminate functionality as an issue. Furthermore, although pop-up advertisement is intrusive and unpredictable, it is certainly not

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uncontrollable, since the user can simply close the pop-up window, move it, or place something else on top of it. Again, this is not merely a descriptive difference, but a physical difference exhibited by the invention. The Examiner must also appreciate that simple pop-up advertisements could never achieve the physical features of the inventive advertising which are presented in the claims.

The Examiner has made much of functional limitations, using functionality as a vehicle to ignore important features of the claims. This is directly contrary to the dictates of MPEP section 2173.05(g), which provides, in relevant part:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. *Functional language does not, in and of itself, render a claim improper.* In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. (Emphasis Added)

In any event, this has been eliminated as an issue in the present claims.

Also, it is eminently clear that JUNO does not include the novel feature combination of the Initial Claim Group.

In the paragraph bridging pages 6 and 7 of the Office Action, the Examiner makes broad, general allegations about additional features which he alleges to have been found in JUNO. The

Applicant is unable to respond to these because of their broad and general character. However, it is noted that the Examiner now appears to be submitting further information based upon his personal knowledge. The Applicant therefore calls upon the Examiner to submit a further affidavit as required by 37 C.F.R. § 1.104(d)(2), which shall be subject to contradiction or explanation by the affidavits of appropriate experts. In order for the Examiner's personal knowledge to be meaningful, it is important that he specify with more detail exactly those features of JUNO which he believes to apply to specific language of the claims.

For the Examiner's information and for the record, the undersigned is providing further information about JUNO. Attached Exhibit A is a screen print of the JUNO home page. At page 2, the undersigned has highlighted a portion in green which indicates that JUNO is a United Online company.

Exhibit B is a screen print of a page from the United Online website (the URL appears at the bottom of the page). Highlighted in green is a definition of a "Juno pop-up." It should be noted that it is a "full-screen ad unit", which means that it is in its own window, and that it is the "first message to appear as a user logs on." In fact, any experienced user of JUNO would hardly be surprised when a pop-up ad appears as he logs on to the service. On what basis does the Examiner then conclude that the appearance of a pop-up ad is unpredictable to the user? What user has ever logged on to JUNO and not seen a pop-up ad as he logs on to the server? Furthermore, it is clear that a pop-up ad does not appear at any other time.

Attached as Exhibit C is a further page from the United Online website (the URL is indicated at the bottom of the page) that refers to "rich media." Here, a further ad format "floating

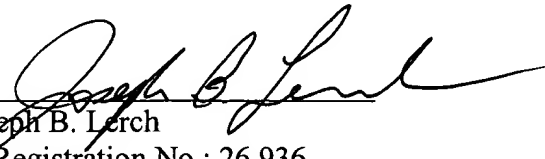
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ads" is referred to. The page is careful not to define this type of ad, but in the sample screen print appearing below the highlighted term, an automobile appears over the page content, which demonstrates a floating ad. The Examiner will not find such ads appearing before they were first introduced by the present assignee and quickly copied by others.

In conclusion, the Examiner has found the claims obvious over JUNO only by ignoring the claim language. The Examiner may have difficulty distinguishing the present invention from the pop-up ads of JUNO, but JUNO does not!

Applicant's attorney has made every effort to place this patent application in condition for allowance. It is therefore earnestly requested that the present amendment be entered, that the application, as a whole, receive favorable reconsideration and that all of the claims be allowed as presently constituted. Should there remain any unanswered questions, the examiner is requested to call the applicant's undersigned attorney at the telephone number given below.

Respectfully submitted,

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